# UNITED STATES PATENT AND TRADEMARK OFFICE

## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Ex parte GUIDO BAUMOELLER, ROLF KAWA, ACHIM ANSMANN and STEPHAN EICHHORN

Appeal No. 2005-1544
Application No. 09/913,378

ON BRIEF

Before GARRIS, KRATZ, and JEFFREY T. SMITH, Administrative Patent Judges.

JEFFREY T. SMITH, Administrative Patent Judge.

## DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10 to 23, which are all of the claims pending in this application.

## BACKGROUND

The Appellants' invention relates to a process for making paper substrates having a soft feel, the process involving providing a paper substrate and an emulsion containing (i) a polyol poly-12-hydroxystearate, (ii) a wax ester and (iii) a wax, and impregnating the paper substrate with the emulsion. (Specification, p. 3).

Representative claim 10 appears below:

> 10. A process for making paper substrates having a soft feel comprising:
> (a) providing a paper substrate;
> (b) providing an emulsion containing:
> (i) a polyol poly-12-hydroxystearate;
> (ii) a wax ester; and
> (iii) a wax; and
> (c) impregnating the paper substrate with the emulsion.

The Examiner relies on the following reference in rejecting the appealed claims:

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| de Haut et al. (de Haut) | 6,207,014 | Mar. 27, 2001 |

Claims 10-23 are rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over de Haut (6,207,014). (Answer, pp. 3-4). We affirm the §103 rejection and reverse the §102 rejection.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Answer

(mailed August 10, 2004) for the Examiner's reasoning in support of the rejection, and to the Brief (filed May 17, 2004) for the Appellants' arguments thereagainst.

We initially note that Appellants assert that for purposes of appeal that the claims do not stand or fall together. (Brief, p. 2). However, we find no separate arguments as to the separate claims as required by 37 CFR § 1.192(c)(7) (2004). Accordingly, all of the claims will stand or fall together and we select claim 10 as representative of claims on appeal and limit our consideration thereto.

OPINION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellants in support of their respective positions. This review leads us to determine that the Examiner's §103 rejection is well founded but that the §102 rejection is not well founded.

According to the Examiner, de Haut discloses impregnating paper with an aqueous softening lotion. The lotion contains the following components 35-95% of a fatty alcohol, 1-50% of waxy esters having a total of 24-48 carbon atoms, up to 20% nonionic/amphoteric emulsifiers, and up to 50% mineral oil or wax. (See col. 5). Exemplary waxy esters are disclosed column 2 and the preferred amount of emulsifier is 1.5 -5%, wax is 1-10%. (See col. 8). One of the preferred non-ionic polyol emulsifier is polyglycerol poly-12-hydroxystearate. (See col. 7). The Examiner

concludes that "the present claims read on and thereby anticipated by the composition of de Haut's lotion. At the very least, it would have been obvious to select those components and amounts which de Haut considered to be preferred over other listed components. Therefore one of ordinary skill in the art would have selected the preferred amount of wax and the polyglycerol poly-12-hydroxystearate the non-ionic emulsifier." (Answer, pp. 3-4).

Appellants argue that de Haut fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element thereof. Specifically, Appellants argue "the '014 [de Haut] reference fails to disclose a combination of the claimed polyol poly-12-hydroxystearate, the claimed wax component, and the claimed amount of wax ester in an emulsion composition for use on paper substrates. (Brief, p. 3).

We agree with Appellants that de Haut does not anticipate the claimed subject matter because it does not provide a disclosure sufficiently specific to direct one skilled in the art to the claimed combination without any need for picking and choosing. See *In re Arkley*, 455 F.2d 586, 589, 172 USPQ 524, 527 (CCPA 1972). Accordingly we determine that the Examiner has not established a *prima facie* case of anticipation with respect to the subject matter of claim 10-23.

Our determination that the disclosure of de Haut does not anticipate the subject matter of the claims does not preclude a finding that the disclosure of de Haut

would have rendered the subject matter of the claims on appeal *prima facie* obvious under 35 U.S.C. § 103 (a). See *Arkley, supra*. Appellants also argue that de Haut fails to render the claimed invention *prima facie* obvious on the grounds that it fails to contain the requisite teaching or suggestion which would have motivated one of ordinary skill in the art to make all of the selections necessary to arrive at the emulsion composition employed in the process of the present invention. (Brief, pp. 3-5).

We do not find Appellants' arguments persuasive. The motivation for modifying the teachings of the prior art to produce the claimed invention can be derived from either in the reference itself or in the knowledge generally available to one of ordinary skill in the art. A person of ordinary skill in the art would have reasonably expected that the components disclosed by de Haunt would have been useful in the process for making paper substrates having a soft feel described by de Haut. "For obviousness under § 103, all that is required is a reasonable expectation of success." *In re O'Farrell*, 853 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

"Once a *prima facie* case of obviousness has been established, the burden shifts to the applicant to come forward with evidence of nonobviousness to overcome the *prima facie* case." *In re Huang*, 100 F.3d 135, 139, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996).

Appellants allege that the present invention provides unexpected results. Specifically, Appellants state "the use of the claimed polyol poly-12-hydroxystearate in combination with both the waxy ester and wax components, it is clearly seen by way of Appellant's examples that the presence of all three components is necessary in order to achieve exceptional softness and skin feel. As a result, the unexpected results associated with the claimed invention are clearly NOT motivated anywhere within the teachings of the '014 reference." (Brief, p. 5).

Having reviewed the data in the specification[1] we determine that the showing in the specification is not commensurate in scope with the degree of protection sought by the claimed subject matter. See *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); *In re Tiffin*, 448 F.2d 791, 792, 171 USPQ 294, 294 (CCPA 1971). It is well settled that "[O]bjective evidence of nonobviousness must be commensurate in scope with the claims.") (quoting *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); In re Dill, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979) ("The evidence presented to rebut a *prima facie* case of obviousness must be commensurate in scope with the claims to which it pertains."). In the present case, the claimed subject matter encompasses a process involving providing a paper substrate and an emulsion containing (i) a polyol poly-12-hydroxystearate, (ii) a wax ester and (iii) a wax, and impregnating the paper substrate

[1] Specification pages 25-26.

with the emulsion. However, the data presented in the specification is limited to testing on a specific paper substrate impregnated with five specific emulsions. These emulsions all use the same polyglyceryl-2-dipolyhydroxystearate and a few examples of the wax component.

Appellants must also explain why the showing is commensurate in scope with the claimed subject matter. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). Appellants have not directed us to evidence that establishes why the relatively few examples presented in the specification would have been representative of the scope of the claimed invention.

Appellants have not explained why the results achieved in the specification would have been unexpected by one of ordinary skill in the art, see *In re Freeman*, 474 F.2d 1318, 1324, 177 USPQ 139, 143 (CCPA 1973); *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972). This is especially significant in this case where the de Haut reference discloses the preparation of similar paper softening compositions that have related properties.

Based on our consideration of the totality of the record before us, having evaluated the *prima facie* case of obviousness in view of Appellants' arguments and evidence, we conclude that the subject matter of claims 10-23 would

have been obvious to a person of ordinary skill in the art from the teachings of the de Haut reference. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

## CONCLUSION

For the foregoing reasons and those set forth in the Answer, based on the totality of the record, we determine that the preponderance of evidence weighs in favor of obviousness, giving due weight to Appellants' arguments and evidence. Accordingly, the Examiner's rejection under 35 U.S.C. § 103 is affirmed.

TIME FOR TAKING ACTION

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(iv)(effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

**Affirmed**

BRADLEY R. GARRIS
**Administrative Patent Judge**

PETER F. KRATZ
**Administrative Patent Judge**

JEFFREY T. SMITH
**Administrative Patent Judge**

**BOARD OF PATENT APPEALS AND INTERFERENCES**

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